Remarks

This response is in reply to the Office communication mailed August 18, 2008. Page and paragraph references are to that Office communication unless otherwise indicated.

Changes Made

Claim 1 has been amended to recite that the method is "performed by a software program running on a general-purpose computer", as described in the specification at paragraph 40 on pages 7-8.[1]

Claim 1 has also been amended to recite that "matériel and/or personnel"[2] resource requirements "and performance metrics" are determined "using a capacity planner component of said software program" (abstract, lines 2-4; Fig. 1: 102); that the investment cost and incremental savings are determined from the resource requirements "using a total cost of ownership (TCO) estimator component of said software program" (abstract, lines 4-6; Fig. 1: 104); that the incremental business value is determined "from said performance metrics, using a business value estimator component of said software program" (abstract, lines 7-9; Fig. 1: 106); and, finally, that a "financial measure" of the "viability" (page 8, ¶ 44) of the alternative server scenario is determined "from said investment cost, said incremental savings and said incremental business value, using a business case builder component of said software program" (abstract, lines 9-11; Fig. 1: 108).

Claim 3 has been cancelled since its limitations are now substantially incorporated into claim 1 as amended.

Claims 1, 4-7 and 20-22 are currently pending in the application.

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[1] Page and paragraph references are to the originally filed version of the application, not the pre-grant publication 2005/0080696.

[2] This is the most apt term for the various non-monetary resource items detailed, for example, in Figs. 13-15 of the specification.

Discussion

Claim 1 as amended is directed to a method for generating a business case for an alternative server infrastructure scenario relative to a baseline server infrastructure scenario, the method being performed by a software program running on a general-purpose computer. In accordance with the invention, there is determined, using a capacity planner component (102) of the software program, matériel and/or personnel resource requirements and performance metrics for the server infrastructure scenarios. From these resource requirements, there is determined, using a total cost of ownership (TCO) estimator component (104) of the software program, an investment cost for the alternative server infrastructure scenario, as well as an incremental savings in operating costs for the alternative server infrastructure scenario relative to the baseline server infrastructure scenario. From the performance metrics there is determined, using a business value estimator component (106) of said software program, an incremental business value to a supported business operation of the alternative server infrastructure scenario relative to the baseline server infrastructure scenario. Finally, there is determined from the investment cost, incremental savings and incremental business value, using a business case builder component (108) of the software program, a financial measure of the viability of the alternative server infrastructure scenario.

Claims 4-7 and 20-22 are dependent on claim 1.

Claim Rejections—35 U.S.C. § 101

Claims 1, 4-7 and 20-22 as previously presented stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter (page 3, ¶ 6).

The Examiner predicates this rejection under § 101 on the alleged deficiencies of claim 1. Specifically, the Examiner notes that for a claimed process to be statutory subject matter under § 101, the process must either (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a particular state or thing, citing Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); and Gottschalk v. Benson, 409 U.S. 63, 70 (1972). Since, the Examiner argues, applicants' claimed process does neither of these things, it is therefore non-statutory. Applicants respectfully disagree.

While the Examiner has correctly stated the test for statutory subject matter, as affirmed most recently in In re Bilski, ___ F.3d ___ (Fed. Cir. Oct 30, 2008), that test clearly does not implicate applicants' claims as amended. As for the first part of the above test ("tied to another statutory class"), the claimed method is performed "by a software program running on a general-purpose computer" and the individual steps are performed by components of that software program. The method is thus tied to another statutory class, specifically, a programmed general-purpose computer, and is thus obviously incapable of being practiced "in the human mind" as asserted by the Examiner with respect to the previously presented claims (page 4).[3]

In this regard, the Examiner is directed to the recent post-Bilski decision of Ex parte Bo Li, ___ USPQ2d ___ (BPAI Nov. 6, 2008), which reversed a rejection under § 101 of the following "program product" claim:

> 42. A computer program product, comprising a computer usable medium having a computer readable program code embodied therein, said computer readable program code adapted to be executed to implement a method for generating a report, said method comprising:
>
> providing a system, wherein the system comprises distinct software modules, and wherein the distinct software modules comprise a logic processing module, a configuration file processing module, a data organization module, and a data display organization module;
>
> parsing a configuration file into definition data that specifies: a data organization of the report, a display organization of the report, and at least one data source comprising report data to be used for generating the report, and wherein said parsing is performed by the configuration file processing module in response to being called by the logic processing module;
>
> extracting the report data from the at least one data source, wherein said extracting is performed by the data organization module in response to being called by the logic processing module;
>
> receiving, by the logic processing module, the definition data from the configuration file processing module and the extracted report data from the data organization module; and
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> organizing, by the data display organization module in respon[s]e to being called by the logic processing module, a data display organization of the report, wherein said organizing comprises utilizing the definition

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[3] This is aside from the near impossibility, as a practical matter, of carrying out the necessary computations by hand or in the head.

> data received by the logic processing module and the extracted report data received by the logic processing module.

In reversing the § 101 rejection, the Board said, in pertinent part (page 9 of slip decision):

> [T]he instant claim presents a number of software components, such as the claimed logic processing module, configuration file processing module, data organization module, and data display organization module, that are embodied upon a computer readable medium. This combination has been found statutory under the teachings of In re Lowry, 32 F.3d 1579 (Fed. Cir., 1994). In view of the totality of these precedents, we decline to support the rejection under 35 U.S.C. § 101.

While applicants' claim 1 is not a program product claim, its recitations of software components are similar in tenor to those of the appealed claim 42 and, for similar reasons, the claim is statutory.

As for the second part of the test, applicants' claims as amended clearly meet this part as well, since the transformations contemplated by this part of the test include data transformations as well as the familiar transformations of manufacturing processes. Indeed, since the typical inputs and outputs of computer systems are data, a contrary rule would all but end patent protection of computer software, a result clearly not contemplated by either Bilski or its predecessors. The data transformations involved here include determining an investment cost and an incremental savings from resource requirements, determining an incremental business value from performance metrics, and determining a financial measure of the viability of a particular scenario from all of the foregoing. These are just as transformative as, say, encryptions or other data transformations whose status as statutory subject matter is well established.

By either of these tests, then, claim 1 as amended and the claims dependent thereon are clearly statutory. Accordingly, the rejection under § 101 is untenable as applied to these claims and should therefore be withdrawn.

Claim Rejections—35 U.S.C. § 103

Claims 1, 4-7 and 20-22 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. pre-grant publication number 2003/0158800 to Pisello et al. ("Pisello") in view of "Official Notice" (page 5, ¶ 8).

Pisello discloses "methods and apparatus" for financial evaluation of information technology (IT) projects. As described in the application, a first software module 302 (Fig. 3) presents to a user various templates from a template database 208 (Fig. 2) for inputting costs and benefits associated with an IT project. The information collected using these templates is then analyzed in accordance with the procedure shown in Fig. 4B and described in the corresponding text.

As previously noted, while Pisello bears certain similarities to applicants' claimed invention, he does not teach determining matériel and/or personnel resource requirements for server infrastructure scenarios, nor does he teach determining an investment cost and incremental savings in operating costs from these resource requirements as claimed by applicants. Rather, Pisello describes (¶¶ 33 and 39) inputting of various expenses and savings as monetary amounts in the first instance and does not describe determining such amounts from previously determined resource requirements.

The Examiner argues in reply that, "[i]n a general sense," Pisello teaches determining the amount of money necessary to support IT projects; since "[m]oney is a resource", Pisello teaches "determining necessary resource requirements for IT projects" (page 2). It is believed that the amendment of claim 1 to refer to "matériel and/or personnel" resource requirements disposes of this argument.

The Examiner argues further that it would not be possible to determine the monetary value associated with a resource without first determining required (non-monetary) resources (page 3). From this latter premise the Examiner apparently concludes (but does not expressly state) that Pisello determines (non-monetary) resource requirements as a necessary antecedent step to determining the amount of money necessary to support an IT project. However, neither the

Examiner's premise nor the conclusion based upon it necessary follows. It may be, for example, that the monetary values entered are based upon rules of thumb rather than any calculation based upon a determination of matériel and personnel resource requirements. Pisello contains no teaching of either determining matériel and/or personnel resource requirements or of determining an investment cost and incremental savings therefrom using components of a software program running on a general-purpose computer as claimed by applicants.

Accordingly, claim 1 as amended, together with claims 4-7 and claims 20-22 dependent thereon, distinguish patentably over the art cited by the Examiner.

Conclusion

Reconsideration of the application as amended is respectfully requested. It is hoped that upon such consideration, the Examiner will hold all claims allowable and pass the case to issue at an early date. Such action is earnestly solicited.

Respectfully submitted,
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